

REMARKS

Applicant appreciates the consideration of the present application afforded by the Examiner. Claims 1-18 were pending prior to the Office Action. Claims 1, 12 and 13 are independent. Claims 8 and 10 have been canceled. Claims 1-7, 9 and 11-13 have been amended. Favorable reconsideration and allowance of the present application are respectfully requested in view of the amendments and remarks made in this response.

Drawings

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) as not showing “the authentication processing and information storing apparatus having a personal information storing device, requester authentication device, access level setting device, personal information output device”. This objection is respectfully traversed.

Applicant has amended the claims to read “circuitry” instead of “device”. According to the 37 C.F.R. § 1.83(a):

- (a) The drawing in a non-provisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings. *See MPEP 1.83(a)*

Thus, based on this regulation, *conventional features* should be illustrated in the drawing in the form of a graphical drawing symbol or labeled representation. Figure 5 of the application shows a “requester authentication section”, “an access level setting section”, “personal information output section” in the form of a labeled rectangular box. Since these items and their inherent circuitry are “conventional features”, and in view 37 C.F.R. § 1.83(a), Applicant submits that the drawings are in compliance with the MPEP.

Moreover, “the authentication processing and information storing apparatus” is shown in Figure 2.

Therefore, it is respectfully requested that the objections to the drawings be withdrawn.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. The Examiner is requesting correction of the following: “device” as recited in claims 1 and 12 and “computer readable medium containing computer executable instructions” as recited in claim 13.

As to claims 1 and 12, in light of the amendment to claims 1 and 12 to read “circuitry instead of “device”, it is respectfully requested that the objections to the specification be withdrawn.

As to computer readable medium claims 13-18, one skilled in the art would readily interpret an IC card as disclosed in the specification to be a computer readable medium. According to the MPEP:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). See MPEP § 2163.07(a).

Thus, because IC card is disclosed in the application, a computer readable medium and/or circuitry is necessarily inherent in the disclosure. Therefore, Applicant respectfully requests that this objection to the specification be withdrawn.

Claim Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-18 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the

claimed invention. More specifically, the Examiner asserts that the elements “personal information storing device”, “accessible person information storing device”, “requester authentication device”, “access level setting device”, “personal information output device”, and “computer readable medium” were not previously disclosed nor could antecedent basis be found in the specification for these terms. However, with regards to the terms containing “device”, it is respectfully requested that this rejection be withdrawn as the term “device” has been amended to read “circuitry”.

With regards to “computer readable medium”, as discussed above, because an IC card is disclosed in the application, a computer readable medium and/or circuitry is necessarily inherent in the disclosure. Thus, the application complies with 35 U.S.C. § 112, first paragraph and it is respectfully requested that these rejections be withdrawn.

Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner asserts that it is unclear what number of devices is being claimed. However, in light of the amendment to claims 1 and 12 wherein the term “device” is amended to read “circuitry” instead, it is respectfully requested that this rejection be withdrawn.

Claim Rejections under 35 U.S.C. § 103

Claims 1, 7, 9-11 and 13 stand rejected under 35 USC §103(a) as allegedly being unpatentable over Deindl et al. (“Deindl”, U.S. 6,031,910) in view of Houvener et al. (“Houvener”, U.S. 6,070,141) further in view of Rankl et al. (“Rankl”, Smart Card Handbook, 2nd Edition). Claims 2-6, 12 and 14-18 stand rejected under 35 USC §103(a) as allegedly being unpatentable over Deindl et al. (“Deindl”, U.S. 6,031,910) in view of Houvener et al. (“Houvener”, U.S. 6,070,141) further in view of Rankl et al. (“Rankl”, Smart Card Handbook, 2nd Edition) further in view of Schneider et al. (“Schneider”, U.S. 6,105,027). Claim 8 stands rejected under 35 USC §103(a) as allegedly being unpatentable over Deindl et al. (“Deindl”,

U.S. 6,031,910) in view of Houvener et. al. (“Houvener”, U.S. 6,070,141) further in view of Examiner’s Official Notice. These rejections are respectfully traversed.

Amended independent claims 1 and 12 clearly recite that the “the information storing apparatus is retained by the owner and comprises an image capturing circuitry for generating the requester characteristic information by capturing an image of the requester”. Amended independent claim 13 clearly recites “wherein the computer readable medium is retained by the owner and generates the requester characteristic information by capturing an image of the requester”. The claimed invention provides an unexpected advantage that the information storing apparatus is able to set the access level for the personal information and outputs the personal information at any place since an external image capturing apparatus is not needed when authenticating the requester (*see ¶64 of the Applicant’s Specification*).

Houvener, however, merely suggests using an image capturing apparatus for taking fingerprints or retinal images (*see Column 9, Lines 16-20*), but is completely silent with regard to the claimed unique feature “the information storing apparatus is retained by the owner and comprises an image capturing circuitry for generating the requester characteristic information by capturing an image of the requester”.

Thus, it is respectfully submitted that Deindl, Houvener and Rankl, alone or in combination, do not teach or suggest amended independent claims 1 and 13 or their dependent claims. It is also respectfully submitted that Deindl, Houvener, Rankl and Schneider, alone or in combination, do not teach or suggest amended independent claim 12, or its dependent claims.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Charu K. Mehta, Reg. No. 62,913, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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